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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/945,467	09/04/2001	Harold F. Hynes		3259

7590 08/27/2003
Harold F. Hynes
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EXAMINER

PASS, NATALIE

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 08/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/945,467

Applicant(s)

HYNES, HAROLD F.

Examiner

Natalie A. Pass

Art Unit

3626

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 24 July 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:


Claim(s) allowed: none.

Claim(s) objected to: none.

Claim(s) rejected: 17-30.

Claim(s) withdrawn from consideration: none.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____


JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER

Continuation of 2. NOTE: Applicant's proposed changes or "authorization" to change claim language would constitute a shift in the scope of the claims and require further search and consideration

Continuation of 5. does NOT place the application in condition for allowance because:

- i. While Applicant's "Clarification of New Matters" provides definitions and explanations to justify the introduction of new matter into the claims, which explains Applicant's intentions, Applicant does not provide the page numbers and line numbers within the originally filed specification which would have shown that the subject matter listed on pages 2-4 of the Final Office Action (paper number 12) was present, and which would have caused the reconsideration of the rejection of the claims due to new matter. It should further be noted that it is not the fact that Applicant uses terms that are common or conventional in the art, but that the Applicant does not point to any specific position of the originally filed specification to justify the use of such terms in reciting the invention as claimed.
- ii. Applicant has not sufficiently addressed the rejections under USC 112 second paragraph for indefiniteness and functional or operational language and lack of antecedent basis. The language of the claim 19 has not been altered in such a way as to allow the withdrawal of this rejection. Claim 19 continues to recite "the finder" in line 3, and "the dot" in line 4 without antecedent basis. The claims are still narrative in form and replete with indefinite and functional or operational language.
- iii. Applicant apparently rehashes arguments previously addressed in the Final Office Action (paper number 12). In particular, each and every limitation of independent claim 17 and of dependent claims 18-30 were properly addressed in pages 6-17 of the detailed Final Office Action, and are incorporated herein. In addition, the motivation to combine the applied references, was clearly accompanied by select portions of the respective references which specifically support that particular motivation [see paper number 12, pages 6-17].
- iv. Applicant analyzes the applied references separately in the Response After Final Office Action, and argues each of the references individually, and therefore fails to consider the full teachings of the applied references. In response to Applicant's piecemeal analysis of the references, it has been held, as noted in the Final Office Action, that one cannot show non-obviousness by attacking references individually where, as here, the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Furthermore, according to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. *In re Jacoby*, 135 USPQ 317 (CCPA 1962).
- v. In response to the argument that if the proposed combination was made, the overall result would not be Applicant's invention, the Examiner respectfully submits that the courts have broadly held that it is sufficient if the prior art clearly suggests doing what Applicant has done, although an underlying explanation of exactly why this should be done is not taught as suggested by the cited references. See *In re Gershon*, 152 USPQ 602 (CCPA 1967). Moreover, the fact that Applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).
- vi. In response to the suggestion that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the Applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).